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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,578	08/20/2003	Patrick Jay Lutz	05408/100K559-US1	5199
7278	7590	10/13/2006	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			STITZEL, DAVID PAUL	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 10/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/644,578		LUTZ	
	Examiner		Art Unit	
	David P. Stitzel, Esq.		1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

OFFICIAL ACTION

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-11 are drawn to a synergistic antimicrobial composition comprising: one or more aldehyde donors; a stabilizer; and dehydroacetic acid or a salt thereof, as classified in class 514, subclass 693.
 - II. Claim 12 is drawn to a method of preparing said synergistic antimicrobial composition, as classified in class 514, subclass 389.
 - III. Claims 13-15 are drawn to a method of inhibiting the growth of or reducing the number of microorganisms comprising applying said synergistic antimicrobial composition to a product or a system, as classified in class 424, subclass 405.
 - IV. Claims 16-19 are drawn to a product comprising said synergistic antimicrobial composition, as classified in class 514, subclass 557.
1. Inventions I and II are related as a product and a method of making said product. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of making the product as claimed can be used to make a materially different product; or (2) the product as claimed can be made by another method that is materially different from the instantly claimed method of making said product. See MPEP § 806.05(f). In the instant case, a synergistic antimicrobial composition as claimed in Invention I can be made by another method that is materially different from the method claimed in Invention II. For example, as opposed to making a synergistic antimicrobial composition as claimed in Invention II, the synergistic

antimicrobial composition claimed in Invention I, may alternatively be made by first solubilizing said one or more aldehyde donors with said dehydroacetic acid to obtain a homogenous mixture, then adding said stabilizer to said homogenous mixture to obtain a homogenous solution.

Inventions I and III are related as a product and a method of using said product, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of using the product as claimed can be practiced with another materially different product; or (2) the product as claimed can be used by another method that is materially different from the instantly claimed method of using said product. See MPEP § 806.05(h). In the instant case, a synergistic antimicrobial composition as claimed in Invention I can be used by another method that is materially different from the method claimed in Invention III. For example, as opposed to a method of using said synergistic antimicrobial composition for inhibiting the growth of or reducing the number of microorganisms as claimed in Invention III, the synergistic antimicrobial composition claimed in Invention I may alternatively be used as a binder for photoconductive substances.

Inventions I and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make a product that is patentably distinct from the instantly claimed final product. See MPEP § 806.05(j). In the instant case, the intermediate product is deemed to be useful for incorporation into an athletic shoe insert so as to reduce odors associated therewith, which is a patentably distinct final product to that of the instantly claimed products of Invention IV.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 802.01 and 806.06. In the instant case, the method claimed in Invention III has a function and effect of inhibiting the growth of or reducing the number of microorganisms, whereas the method claimed in Invention II has a function and effect of preparing a synergistic antimicrobial composition. As a result, the method claimed in Invention III has a materially different function and effect from the method claimed in Invention II, and are therefore unrelated.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 802.01 and 806.06. In the instant case, the product claimed in Invention IV has a function and effect of inhibiting the growth of or reducing the number of microorganisms, whereas the method claimed in Invention II has a function and effect of preparing a synergistic antimicrobial composition. As a result, the product claimed in Invention IV has a materially different function and effect from the method claimed in Invention II, and are therefore unrelated.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicants are therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

2. Claims 1, 3-5, 8, 9 and 12 are generic to a plurality of disclosed patentably distinct species of aldehyde donor. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different physicochemical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are further required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of either an aldehyde donor (i.e., 1,3-dimethylol-5,5-dimethylhydantoin), or a specific mixture of aldehyde donors (i.e., a mixture of 1,3-dimethylol-5,5-dimethylhydantoin and 1-methylol-3-methylloxymethylene-5,5-dimethylhydantoin), for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1, 3-5, 8, 9 and 12 are generic. In addition to including a listing of all claims, as well as any claims subsequently added thereto, which are readable upon the elected species, Applicants should also include a chemical structure or a molecular formula of the elected compound, if a chemical structure or a molecular formula of said compound is not already contained within the instant specification. If Applicants are unable to provide the chemical structure or the molecular formula of said compound, the CAS (Chemical Abstract Service) number assigned to said compound will suffice.

3. Claims 1, 6, 10 and 12 are generic to a plurality of disclosed patentably distinct species of stabilizer. The disclosed species are patentably distinct, each from the other, because they possess different molecular structures, as well as different physicochemical properties. Therefore, restriction for examination purposes as indicated is proper.

Even though this requirement is traversed, Applicants are further required under 35 U.S.C. § 121 to elect, for search purposes only, a single disclosed patentably distinct species of stabilizer (i.e., 5,5-dimethylhydantoin), for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1, 6, 10 and 12 are generic. In addition to including a listing of all claims, as well as any claims subsequently added thereto, which are readable upon the elected species, Applicants should also include a chemical structure or a molecular formula of the elected compound, if a chemical structure or a molecular formula of said compound is not already contained within the instant specification. If Applicants are unable to provide the chemical structure or the molecular formula of said compound, the CAS (Chemical Abstract Service) number assigned to said compound will suffice.

Conclusion to Restriction Requirement

The Examiner has required restriction between product, methods of making, and methods of using claims. Where Applicants elect claims directed to a product, and the product claim is subsequently found allowable, withdrawn methods of making and methods of using claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Methods of making and methods of using claims that depend from or otherwise include all the limitations of the patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined methods of making and methods of using claims will be withdrawn, and the rejoined methods of making and methods of using claims will be fully examined for patentability in

accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and methods of making and methods of using claims may be maintained. Withdrawn methods of making and methods of using claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicants are advised that the methods of making and methods of using claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

Applicants are advised that a fully responsive reply to this requirement must include an explicit identification of a single disclosed patentably distinct species of either an aldehyde donor (i.e., 1,3-dimethylol-5,5-dimethylhydantoin), or a specific mixture of aldehyde donors (i.e., a mixture of 1,3-dimethylol-5,5-dimethylhydantoin and 1-methylol-3-methylloxymethylene-5,5-dimethylhydantoin), as well as a single disclosed patentably distinct species of stabilizer (i.e., 5,5-dimethylhydantoin), that is elected consonant with this requirement, and a listing of all claims, including any claims subsequently added thereto, which are readable upon the elected species. An argument that a claim is allowable or that claims are not generic is considered

nonresponsive unless accompanied by an explicit election of a specific species and subspecies.

See 37 C.F.R. § 1.143.

Should Applicants traverse on the ground that the species are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the species and subspecies to be obvious variants over one another or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other inventions.

If claims are added after the election, Applicants must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named Inventors is no longer an actual Inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Due to the complex nature of the instant restriction requirement, a written restriction requirement was necessitated. See MPEP § 812.01.


Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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